

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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|-------------|--|-------------------|------------------------------|
| Applicants: | Annaliesa S. Anderson, <i>et al.</i> | | |
| Serial No.: | 10/564,458 | Case No.: 21569YP | Art Unit: 1645 |
| Filed: | January 12, 2006 | | |
| For: | POLYPEPTIDES FOR INDUCING A PROTECTIVE IMMUNE RESPONSE AGAINST STAPHYLOCOCCUS AUREUS | | Examiner: Devi, Sarvamangala |

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

PETITION TO WITHDRAW FINALITY OF OFFICE ACTION

MAILED APRIL 13, 2011

Sir:

Pursuant to 37 C.F.R. § 1.181, applicants request the finality of the office action mailed April 13, 2011 be withdrawn as premature. It is respectfully submitted the April 13, 2011 office action reopening prosecution on the basis of newly cited art, and making the action final, failed to take into account applicants' certification in compliance with 37 C.F.R. § 1.97 (e). Under MPEP § 1207.04 the rejection should not have been made final.

MPEP § 1207.04 entitled "Reopening of Prosecution after Appeal [R-8]" provides:

The examiner may, with approval from the supervisory patent examiner, reopen prosecution to enter a new ground of rejection after appellant's brief or reply brief has been filed. The Office action containing a new ground of rejection may be made final **if the new ground of rejection was (A) necessitated by amendment, or (B) based on information presented in an information disclosure statement under 37 CFR 1.97(c) where no statement under 37 CFR 1.97(e) was filed.** See MPEP § 706.07(a). Any after final amendment or affidavit or other evidence that was not entered before must be entered and considered on the merits. (Emphasis added.)

(Manual of Patent Examining Procedure, Rev. 8, July 2010, at 1200-32.)

No fees are believed due in connections with this petition. If any fees are required, Applicants request and authorize that the appropriate fees be taken from Merck Deposit Account No. 13-2755.

Statement of Facts

1. Applicants filed an Appeal Brief on July 23, 2010.
2. The patent office mailed an Examiner's Answer on November 10, 2010.
3. Applicants filed a Reply Brief and Request for Oral Hearing on January 10, 2011.
4. On January 20, 2011, applicants filed a Communication and Informational Disclosure Statement (IDS) providing the patent office with a copy of an opposition filed on a corresponding European application, a reference cited in the opposition, and the notice of the opposition. Applicants' submission did not include any amendments to the claims.
5. The January 20, 2011 Communication pointed out that the European opposition was filed not more than three month prior to the filing of the IDS, and included copies of the The Notice of Opposition and Opposition statement with dates confirming applicants assertion.
6. The January 20, 2011 IDS included a certification under 37 C.F.R. 1.97, complying with 37 C.F.R. 1.97 (e)(1), by checking off a box indicating the following:
the Information Disclosure Statement is filed on or before payment of the issue fee and each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. Authorization is therefore given to charge Deposit Account No. 13-2755 for the fee required under 37 C.F.R. 1.17(p).
(See Exhibit A attached hereto.)
7. On April 13, 2011 the patent office reopened prosecution, providing a new rejection based on the art cited in the opposition, and made the rejection final. The examiner indicated that applicants' January 20, 2011 submission prompted the new rejection, and cited to MPEP § 609.04(4). (Office Action mailed April 13, 2011, at page

34, paragraph 16.) No specific section of MPEP § 609.04(4) providing a basis for making the rejection final was cited. No mention was made regarding applicants' certification under 37 C.F.R. 1.97 (e).

Summary

The April 13, 2011 office action was improperly made final. Applicants' January 20, 2011 submission did not include any amendments to the claims and provided a certification under with 37 C.F.R. 1.97 (e).

Respectfully submitted,

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EXHIBIT A

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Annaliesa S. Anderson, et al.

Serial No.: 10/564,458

Docket No.: 21569YP

Filed: January 12, 2006

For: POLYPEPTIDES FOR INDUCING A PROTECTIVE
IMMUNE RESPONSE AGAINST
STAPHYLOCOCCUS AUREUS

Art Unit: 1645

Examiner: S. J. N. Devi

Conf. No.: 7338

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. 1.97

Sir:

1. In compliance with 37 C.F.R. 1.97, submitted on form PTO/SB/08a is a list of patents, publications or other information that are requested to be made of record in this application. This Information Disclosure Statement is not an admission that any patent, publication or other information referred to herein is "prior art" for this invention. In accordance with 37 C.F.R. 1.97(h), the filing of this Information Disclosure Statement shall not be construed to be an admission that the information in the Statement is, or is considered to be, material to patentability as defined in 37 C.F.R. 1.56(b).

2. In accordance with 37 C.F.R. 1.97(g), the filing of this Information Disclosure Statement shall not be construed to mean that any search has been made.

3. Pursuant to 37 C.F.R. 1.98(a)(2)(ii), copies of each U.S. patent and each U.S. patent application publication are not enclosed herewith.

4. Applicants respectfully request that the Examiner initial the attached form PTO/SB/08a after reviewing the pertinence of each reference.

5. Pursuant to 37 C.F.R. 1.98(d), copies of references listed on the attached form that were submitted to or cited by the Office in a related application upon which the instant application relies for an earlier filing date under 35 U.S.C. §120 are not enclosed. Related application(s) in which references were submitted to or cited by the Office are as follows:

| RELATED APPLICATION | | |
|---------------------|-------------|------------|
| U.S. SERIAL NUMBER | FILING DATE | MERCK CASE |
| | | |
| | | |

If this is inconvenient, additional copies will be submitted upon request.

6. In accordance with 37 C.F.R. 1.97, (check one)

- ☐ the attached information is filed within three months of the filing date of the captioned case. Accordingly, it is believed that no fee is due.
- ☐ the attached information is filed more than three months after the filing date but prior to the mailing of a first Office Action on the merits. Accordingly, it is believed that no fee is due.
- ☐ the attached information is filed before the mailing of a first Office Action after the filing of a Request for Continued Examination under §1.114. Accordingly, it is believed that no fee is due.
- ☐ the attached information is being filed more than three months after the filing date and after the mailing of a first Office Action on the merits, but before the mailing date of a Final Action, Notice of Allowance, or an action that otherwise closes prosecution in the application. Authorization is therefore given to charge Deposit Account No. 13-2755 for the fee required under 37 C.F.R. 1.17(p).
- ☒ the Information Disclosure Statement is filed on or before payment of the issue fee and each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. Authorization is therefore given to charge Deposit Account No. 13-2755 for the fee required under 37 C.F.R. 1.17(p).
- ☐ each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart application and this communication was not received by any individual designated in §1.56(c) more than thirty days prior to the filing of this Information Disclosure Statement. Accordingly, it is believed that no fee is due.
- ☐ no item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual designated under 37 C.F.R. §1.56(c) more than three months prior to the filing of this Information Disclosure Statement. Accordingly, it is believed that no fee is due.

Respectfully submitted,

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Date: January 20, 2011